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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,819	02/22/2002	Edward O. Clapper	ITL.0694US (P13225)	3076

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EXAMINER

ANWAH, OLISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,819

Applicant(s)

CLAPPER, EDWARD O.

Examiner

Olisa Anwah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 15-22, 24 and 31-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14, 23, 25-30 and 38-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9-14, 23, 25-29 and 39-46 are rejected under 35 U.S.C § 103(a) as being unpatentable over Windsor et al, U.S. Patent No. 5,734,706 (hereinafter Windsor) in view of Suzuki, U.S. Patent Application Publication No. 2001/0027098 (hereinafter Suzuki).

Regarding claim 9, Windsor discloses a system comprising:

a device separate from a telephone (26) and a computer (the telephone company's electronic directory service from column 11) and connectable to at least one of a telephone line or the computer, the device having a processor; a storage coupled to the processor to store a first database with a plurality of records, each containing a telephone number, a name and other information; and an application

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stored in said storage to enable the processor to access the telephone number of a second party to an ongoing telephone call, search said first database for a record containing said telephone number, and display a name, telephone number and other information associated with said record on the device (see Figure 4D).

Windsor fails to teach the device is a standalone portable device. All the same Suzuki discloses this limitation (see unit 2 from Figure 2). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Windsor with the device of Suzuki. This modification would have improved the convenience of Windsor by saving precious desk space.

Regarding claim 23, Windsor discloses a method comprising:

receiving in a first system (34) a search query (168 from Figure 4D) for information associated with a second party during a telephone call, the first system comprising a device separate from a telephone (26) and a computer (the telephone company's electronic directory service from

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column 11) and connectable to at least one of a telephone

(26) line or the computer (col. 12, line 1-5);

obtaining the information from the system if it is present in the first system (174);

searching at least one remote source for the information if it is not present in the first system (col. 11, line 36 and lines 60-65);

providing the information to the first system from the remote source and displaying the information on the first system (col. 11, lines 45-50 and Figure 4D).

Windsor fails to teach the device is portable. All the same Suzuki discloses this limitation (see unit 2 from Figure 2). As a result, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Windsor with the device of Suzuki. This modification would have improved the convenience of Windsor by saving precious desk space.

Regarding claim 25, see col. 11, line 66 of Windsor.

Regarding claim 26, see col. 11, line 52 of Windsor.

Regarding claim 27, see col. 11, line 30 to col. 12, line 10 of Windsor.

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Regarding claim 28, see col. 3, line 2 of Windsor.

Regarding claim 29, see col. 11, line 30 to col. 12, line 10 of Windsor.

Regarding claim 39, see col. 11, line 30 to col. 12, line 10 of Windsor.

Regarding claim 10, see col. 9, lines 20-30 of Windsor.

Regarding claim 11, see col. 11, line 30 to col. 12, line 10 of Windsor.

Regarding claim 12, see col. 11, line 30 to col. 12, line 10 of Windsor.

Regarding claim 13, see paragraph 0072 of Suzuki.

Regarding claim 14, see col. 3, lines 1-5 of Windsor.

Regarding claim 41, see column 11 of Windsor.

Regarding claim 42, see Figure 1 of Windsor.

Regarding claim 43, see abstract of Suzuki.

Regarding claim 44, see Figure 1 of Windsor.

Regarding claim 45, see abstract of Suzuki.

Regarding claim 46, see column 11 of Windsor.

3. Claim 38 is rejected under 35 U.S.C § 103(a) as being unpatentable over Windsor combined with Suzuki in further

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view of Brenner et al, U.S. Patent No. 6,206,593

(hereinafter Brenner).

Regarding claim 38, the combination of Windsor and Suzuki teaches a printer for printing caller identification information (50 from Figure 2 of Windsor). The Windsor-Suzuki does not teach the printer is housed in the portable device. However Brenner discloses this limitation (see Figures 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26 and 27). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Windsor and Suzuki with the printer taught by Brenner. This modification would have simplified the design of Windsor by saving precious desk space.

4. Claim 30 is rejected under 35 U.S.C § 103(a) as being unpatentable over Windsor combined with Suzuki in further view of DeFazio et al, U.S. Patent No. 5,940,484 (hereinafter DeFazio).

Regarding claim 30, Windsor teaches the plurality of remote sources includes a remote service provider (col. 11, lines 60-65). Windsor fails to teach the plurality of

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remote sources includes the Internet. However DeFazio discloses this limitation (col. 3, line 51). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Windsor-Suzuki combo with a method wherein the remote source includes the Internet. This modification would have modernized Windsor by retrieving ANI information from a plurality of databases as suggested by Windsor, Suzuki and DeFazio.

Response to Arguments

5. Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

OA
Olisa Anwah
Patent Examiner
June 9, 2005



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600